

S/N 09/304,444

Response to Office Action Dated 07/25/2005

**REMARKS**

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. This amendment is believed to be fully responsive to all issues raised in the 07/25/2005 Office Action.

**In the Claims:**

No claims are added.

Claims 3, 6, 8, 12, 16, 18 and 19 are original.

Claims 7 and 15 are currently amended.

Claims 1, 4, 5, 11, 17 were previously presented.

Accordingly, claims 1 and 3—8, 11—12, 15—19 are pending.

**The §103 Rejections**

The Applicant submits that the Office has failed to establish a *prima facie* case of obviousness and, in view of the comments below, respectfully traverses the Office's rejections. However, before discussing the substance of the Office's rejections, a section entitled "The §103 Standard" is provided and will be used in addressing the Office's rejections. Following this section, a section entitled "The Vanstone Reference" is provided, which describes Vanstone's disclosure and teachings.

**The §103 Standard**

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. MPEP § 2142. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable

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1 expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375  
2 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined)  
3 must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180  
4 USPQ 580 (CCPA 1974).

5 Hence, when patentability turns on the question of obviousness, the search  
6 for and analysis of the prior art includes evidence relevant to the finding of  
7 whether there is a teaching, motivation, or suggestion to select and combine or  
8 modify the references relied on as evidence of obviousness. The need for  
9 specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371,  
10 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to  
11 the reason the skilled artisan, with no knowledge of the claimed invention, would  
12 have selected these components for combination in the manner claimed").

### 13 The Vanstone Reference

14 In contrast to the Applicant's claims reciting "a memory device" and "a  
15 smart card" for interface to "a common computer", Vanstone discloses a system  
16 comprising only a terminal and a smart card. In particular, Vanstone discloses a  
17 method for verifying the authenticity of messages exchanged between a pair of  
18 correspondents (Vanstone, Abstract), such as a smart card and a terminal (column  
19 2, lines 42—43). The verification is performed according to first and second  
20 signature algorithms (column 2, lines 43—53). Notably, a memory device—i.e. a  
21 device that is distinct from the smart card and the terminal (computer), as is the  
22 case in the Applicant's claims—is not present in the Vanstone system.

23 Vanstone teaches away from the Applicant's verification of a smart card  
24 and a memory device. In particular, Vanstone's method of verification requires—  
25 in contrast to the capabilities of memory devices—that processing power be

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1 available within each of the two devices within the verification system. In  
2 particular, Vanstone discloses: use of an RSA algorithm for the card to verify the  
3 terminal (column 3, lines 17—25); and, use of an elliptic curve algorithm for the  
4 terminal to verify the card (column 3, lines 25—30). Thus, because both devices  
5 in the verification scheme must have the ability to process their ends of both  
6 algorithms, Vanstone teaches away from verification of a memory device that is  
7 not suited for such processing.

8 The Vanstone system and protocol, which is intended for a smart card and a  
9 terminal, is not adaptable to verification of a smart card and a memory device  
10 interfaced to a computer. In particular, the teachings of the Vanstone disclosure  
11 are operable only if each device (smart card and terminal) has some processing  
12 power to implement the protocol. The processing power is necessary to operate  
13 Vanstone's challenge-response protocol (column 3, lines 17—18) for  
14 authenticating a smart card and terminal. Thus, the Vanstone system and protocol  
15 is not adapted to verifying a smart card and a memory device, since the memory  
16 device would not be able to perform the challenge-response algorithm  
17 calculations.

18 The Vanstone method and/or protocol cannot be configured to enable  
19 and/or disable access to "a memory device" using "a smart card" interfaced with a  
20 "common computer". Vanstone discloses a terminal and a smart card, but does  
21 not disclose an additional memory device; i.e. Vanstone does not disclose a  
22 memory device that is attached to the computer along with the smart card. Thus,  
23 the Vanstone disclosure discloses no teachings that explain verification of such a  
24 memory device. Nothing in Vanstone, *which presupposes that the devices to be*  
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1 *verified have processing power*, would suggest that Vanstone could be applied to  
2 such a system as recited by the Applicant's claims.

3 **Traversal of the §103 Rejections**

4       **Claims 1, 3, 6—8, 12 and 16—17** are rejected under 35 U.S.C. §103(a) as  
5 being unpatentable over U.S. Patent No. 5,623,637, hereafter "Jones" in view of  
6 U.S. Patent No. 6,178,507, hereinafter "Vanstone." The Applicants respectfully  
7 traverse the rejection and request that the rejection be reconsidered and withdrawn.

8  
9       **Claim 1** recites a system for porting user data from one computer to  
10 another comprising:

- 11       • a memory device to store the user data;
- 12       • a smart card associated with a user that alternately enables access to  
13       the user data on the memory device when both the memory device  
14       and smart card are interfaced with a common computer and disables  
15       access to the user data when one of the memory device or smart card  
16       is absent; and
- 17       • wherein the memory device stores a public key and the smart card  
18       stores a corresponding private key and access to the user data in the  
19       memory device is enabled upon verification that the public key and  
20       the private key are associated.

21       The references of record fail to disclose a "*memory device (that) stores a*  
22 *public key* and the smart card stores a corresponding private key and access to the  
23 user data in the memory device is enabled upon verification that the public key  
24 and the private key are associated". The Vanstone reference was cited for this  
25 purpose; however, for the reasons seen herein, Vanstone fails to disclose a system  
and/or protocol that discloses the elements recited.

26       The Applicant observes that the Vanstone reference does not disclose  
27 storage of a public key in a memory device and storage of a corresponding private

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1 key in a smart card. Instead, Vanstone discloses a challenge/response protocol  
2 between a smart card and a terminal. No separate memory device is disclosed;  
3 accordingly, storage of the public key in a memory device (separate from the  
4 “smart card” and “common computer”) is not shown.

5 The Vanstone system and protocol, which is intended for verification of a  
6 smart card and a terminal, is not adaptable to verification of a smart card and a  
7 memory device. The Applicant recites a smart card and a memory device,  
8 wherein both are connected to “a common computer”. As seen in the above  
9 section entitled “The Vanstone Reference”, which is incorporated herein by  
10 reference, the Vanstone protocol requires that both devices have at least some  
11 processing power. Because there is no reason to believe that a memory device  
12 could perform the algorithms disclosed by Vanstone, the teachings of Vanstone  
13 are not adapted to verifying the association of a smart card and a memory device,  
14 as recited by the Applicant’s claims. Therefore, the Applicant’s system is able to  
15 do what Vanstone’s system is not able to do—i.e. verify keys without requiring a  
16 memory device to perform calculations that it cannot perform.

17 The Patent Office suggests that Vanstone’s system and protocol can be  
18 adapted to verify a smart card and memory. However, the Patent Office appears to  
19 concede that, for the Vanstone system to operate, the memory device must be  
20 considered to be the terminal (see Office Action mailed 07/25/2005, page 4, line  
21 2). This concession is necessary because the Vanstone disclosure requires that, for  
22 the two devices to be mutually verified, each must have sufficient processing  
23 power to perform according to the two challenge/response algorithms (see column  
24 3, lines 17—25 and 25—30, and 16—17). Moreover, Vanstone does not address  
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1 any contingencies for adapting the algorithm to a case wherein one of the devices  
2 to be verified is a memory device.

3 The Applicant's claims recite a working system that does not make  
4 processing demands on the memory device. In contrast, the Vanstone reference  
5 cannot be adapted for operation between "a smart card" and "a memory device"  
6 "interfaced with a common computer", as recited by the Applicant's claim. This  
7 is because Vanstone's technology is configured to operate between a smart card  
8 and a terminal, where each device has sufficient processing power to perform the  
9 required algorithm steps. In contrast, the arrangement recited in the Applicant's  
10 claims is operable even though *the memory device has no processing power.*  
11 Therefore, incompatibilities between the Vanstone technology and elements  
12 recited in the claims render Vanstone's method ineffective within the context of  
13 the claims.

14 Therefore, because the Vanstone reference is not adaptable to the  
15 verification of a memory device and a smart card interfaced to a computer system,  
16 the Applicant respectfully requests that the rejection of claim 1 be removed.

17 **Claim 7 is representative of independent claims 5, 11, 15, 17, 18 and 19,**  
18 **and recites a computer system, comprising:**

- 19 • a computer having an interface; and
- 20 • a profile carrier adapted to use the interface, the profile carrier  
21 comprising a smart card associated with a user and a memory device  
22 having data memory to store a user's profile, wherein the smart card  
23 alternately enables access to the user's profile when present and  
24 disables access to the user's profile when absent;
- 25 • wherein the smart card stores a first key;
- wherein the data memory stores a second key that is associated with  
the first key;
- wherein the smart card is configured to authenticate the second key  
from the data memory using the first key as a condition for enabling  
access to the user data.

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1        As seen in the discussion of Claim 1, the Vanstone reference does not  
2        disclose a system and/or protocol that is adaptable to authenticate a smart card  
3        with respect to a memory device, wherein the smart card and memory device are  
4        interfaced to a computer. Vanstone instead discloses a protocol that authenticates  
5        a smart card with respect to a terminal. Vanstone requires that both of the two  
6        devices to be authenticated perform either the signature and/or verification  
7        protocol associated with the RSA and/or elliptic curve algorithm (see Vanstone,  
8        column 3, lines 10—36). Thus, Vanstone discloses a method to authenticate  
9        devices that are configured to perform such computations. Moreover, Vanstone's  
10       teachings do not suggest any means for adaptation to a system, as recited, wherein  
11       one of the devices is a memory device.

12       The Patent Office repeats the rejection as stated with respect to claim 1.  
13       Accordingly, the Applicant incorporates the arguments above herein. As a result,  
14       claims 5, 11, 15, 17, 18 and 19 are allowable for substantially the same reasons  
15       that claim 1 is allowable, as seen above, as well as for reasons associated with the  
16       elements recited by each claim individually.

17       Claims 3, 4, 6, 8, 12 and 16 depend from the above-mentioned  
18       independent claims and are allowable as depending from an allowable base claim.  
19       These claims are also allowable for their own recited features that, in combination  
20       with those recited in the corresponding base claim, are neither disclosed nor  
21       suggested in references of record, either singly or in combination with one  
22       another.

### 23       Conclusion

24       Claims 1 and 3—8, 11—12, 15—19 are in believed to be in condition for  
25       allowance. Applicant respectfully requests reconsideration and prompt issuance of

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1 the present application. Should any issue remain that prevents immediate issuance  
2 of the application, the Examiner is encouraged to contact the undersigned attorney  
3 to discuss the unresolved issue.

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5 Respectfully Submitted,  
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